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10/723,090	11/25/2003	Ronald L. Coleman		7901

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EXAMINER

LOWEN, ALYSSA

ART UNIT PAPER NUMBER

3714

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/723,090

Applicant(s)

COLEMAN, RONALD L.

Examiner

Alyssa M. Lowen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☒ Claim(s) 6, 7, and 16-21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, resonance chamber, guide, alignment groove, and mounting plate must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Reference number 64 on page 7 paragraph 3.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

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and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The abstract of the disclosure is objected to because of multiple spelling errors, making it unclear and confusing. Correction is required. See MPEP § 608.01(b).
5. The disclosure is objected to because of the following informalities: The top lines on pages 2, 4, 6 and 9 contain many errors where the letter "e" is missing from multiple words. A variety of other spelling errors were found that could make the specification difficult to understand. Some examples being on page 9 paragraph 2, the use of the word "intention" where "invention" is meant, and on page 2 paragraph 4, the use of the word "mammals" in a context that is not correct.

Appropriate correction is required.

Claim Objections

6. Claims 6, 7, and 18 are objected to because of the following informalities: Misspelling of the words "accessory," "resonance" and "disengagement" respectively. Appropriate correction is required.

7. Claims 16-21 are objected to because of the following informalities: The preamble, "In combination" is not proper. A preamble should comprise a general description of all the elements or steps of the claimed combination that are conventional or known. Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 13, 14, and 16-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 13 states the actuation means moves "said at least on structure" where no previously mentioned aspect of the device comes close to this description and is therefore unclear as to what is meant by this phrase. Claim 16 states "a clamping means for clamping said enclosure the bicycle proximate said at least one tire" which is extremely unclear as to what is meant and furthermore the "said at least one tire" lacks positive antecedent basis since a tire was not previously mentioned in the claim. Claims 14 and 18 make mention to a "plurality of structures" which is vague and unclear since it is unknown how these structures interact with the previously mentioned elements of the device. In claim 20 the stated "said mounting assembly" lacks positive antecedent basis since no prior mention to a mounting assembly was made, so it is unclear as to what the mounting assembly is meant to include. Claims 17-20 depend on claim 16 and claim 21 is dependent on claim 20 making them unclear by association.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-3, 6, 8-12 and 14-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Perea (6039338). With regard to claims 1, 8 and 15-16, Perea discloses a sound accessory having an enclosure (46) with clamping attachment means to secure the enclosure proximate a bicycle wheel with spokes (Fig. 1) and a second attachment means (52 and 54) for detachably attaching an interchangeable sound-producing element (58) to the enclosure such that a portion of the wheel, in particular the spokes, when moved impact the sound-producing element to create a sound (Fig. 1).

Regarding claims 2 and 9, the attachment means is a clamp having a circular channel (Fig. 2) and a tightening means for attaching the clamp to a cylindrical member of a bicycle (30). With regard to claim 3 and 15, the interchangeable sound-producing element is planar (Fig. 2A). As for claims 6 and 17, a chamber (48) is located within the enclosure. Regarding claim 10, Perea shows the accessory attached to the seat stay of a bicycle (Fig. 1). With regard to claims 11 and 14 the second attachment means has a plurality of structures in the form of a projection (56), sound-producing element flap (58) and a stop (52) that selectively interlock within the enclosure. Regarding claims 12 and 18, the projection and flap have an engagement position and disengagement position since it can be slid in and out of the chamber in the enclosure in order to change the sound-producing element (column 4 line 6).

11. Claims 1,8,11-13, 16 and 18-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Onori (6234864). Onori discloses a sound accessory having an

enclosure for holding the sound-producing element (Fig. 2), also clamping attachment means (20) to secure the enclosure proximate a bicycle wheel with spokes (Fig. 1) and a second attachment means (80) for detachably attaching an interchangeable sound-producing element (60) to the enclosure such that a portion of the wheel, in particular the spokes, when moved impact the sound-producing element to create a sound (Fig. 1). Regarding claims 11-13, the second attachment means (80) has a projection (Fig. 4) that can be engaged and disengaged from the enclosure by actuation means in the form of a latch (84). With regard to claims 18 and 19, the plurality of structures includes a projection (Fig. 4) and a recess (85) that can be engaged and disengaged from the enclosure by actuation means in the form of a latch (84). In regard to claim 20, the second attachment means contains a mounting plate (80), a third attachment means for securing the interchangeable sound-producing element in the form of a peg (73) and a projection that is sized to fit in an opening in the enclosure (86) and is released with a latch (Fig. 4). Guides (81 and 82) extend from the mounting assembly and are sized to fit in a channel within said enclosure (71 and 72) where the guiding means guides the mounting assembly when it is slid into position (Fig. 4) and the enclosure contains an alignment groove at the top and bottom of the channel (75) when it is turned on its side for normal operational use.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claims 4 and 5 rejected under 35 U.S.C. 103(a) as being unpatentable over Perea in view of Randmae (5611558). Perea discloses the basic inventive concept substantially as claimed except for the sound-producing element having a texture on the surface or voids within it. Randmae, however depicts a sound element having voids (Fig. 5) and a texture (Fig. 9) showing these features to be old in the bicycle noisemaker art. It would have been obvious to one of ordinary skill in the art at the time of invention from the teaching of Randmae to modify the sound-producing element of Perea by adding either the texture or voids to the sound element in order to change the sound quality of the device and also to make the device more visually appealing.

15. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perea in view of Sorensen (5085611). Perea discloses the basic inventive concept substantially as claimed with the exception of a resonance chamber located within the enclosure. Sorensen describes a bicycle amusement device having a resonance chamber (34) showing this feature to be old in the art. It would have been obvious to one of ordinary skill in the art at the time of invention from the teaching of Sorensen to modify the

chamber of Perea by making it a resonance chamber in order to amplify the sound of the device making it louder and more easily heard.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyssa M. Lowen whose telephone number is (571) 272-2684. The examiner can normally be reached on M-F (8-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Jessica Harrison can be reached on 571-272-4449. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AML

Chanda L. Harris
CHANDA L. HARRIS
PRIMARY EXAMINER